

## **REMARKS**

### **Status of the Claims**

Claims 1-17, 33, and 34 are now pending. Non-elected claims 18-32 were previously canceled without prejudice or disclaimer. Independent claim 1 and dependent claims 2, 9, 12-14, 33, and 34 have been amended to improve clarity without the introduction of any new matter.

Reconsideration of this application, as amended, is respectfully requested.

### **Improper Reference Citation**

Applicants thank the Examiner for correcting the previous incorrect citation of the bellow-noted Abileah et al. reference and the issuance of this Office Action to restart the period for response.

### **Rejections under 35 U.S.C. § 103**

#### **A. Claims 1, 3-7, and 15**

Claims 1, 3-7, and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Abileah et al. (U.S. Patent Application Publication No. 2002/0038336, hereinafter “Abileah”) in view of Sakanishi (U.S. Patent No. 6,678,888). This rejection is respectfully traversed.

The outstanding Action suggests that paragraph [0077] of Abileah discloses a “connector obtaining unit **responsive to the application management unit determination of the connector**” so as to obtain the connector” (emphasis added) in terms of disclosing “connection **creation** for a connector that is required to match interface requirements between an adapter and an application” (emphasis added). However this “**creation**” required “to match interface requirements between an adapter and an application” is not reasonably equitable to the claim 1 required obtaining of the connector “**responsive to the application management unit determination of the connector.**”

What is missing from the outstanding Action is any attempt to explain what in Abileah can reasonably be said to teach the claim 1 “application managing unit **that analyzes application data to determine a connector that specifies information indicating a function required for executing said application**” (emphasis added) or how paragraph [0077] of Abileah teaches the creation of a connector using the disclosed “standardized metamodels” that is in any

manner responsive to this required “determination of the connector” by a nonexistent “application management unit”.

In this last regard, a careful consideration of Abileah makes it clear that this reference does not teach or even remotely suggest any analysis of application data to determine “a connector that specifies information indicating a function required for executing said application.” To whatever extent that Sakanishi is relied upon to teach the missing “application managing unit” the claim 1 “application managing unit” must analyze “application data to determine a connector that specifies information indicating a function required for executing said application” and not to simply analyze “application data to determine information indicating a function required for executing said application” as stated at page 3, lines 10-12 of the outstanding Action.

Thus, to whatever extent that col. 8, lines 53-61 of Sakanishi teaches analyzing a “software information file” for each software distribution to determine premise software<sup>1</sup> “or a premise-software management table” that can be used to determine what “other software is required for distribution of specific software,” these teachings have everything to do with software distribution and nothing to do with determining a “connector.” Sakanishi is clearly not even analogous art that can be used in an obviousness rejection. As noted in MPEP § 2141.01(a), in order for any examiner to rely on a reference under 35 U.S.C. § 103, it must be analogous prior art. Here the references are in clearly different fields of endeavor. That being the case, it must be shown that the software distribution subject matter of col. 8, lines 53-61 of Sakanishi logically would have commended itself to an inventor's attention based on some common problem associated with the claimed invention that involves the determination of an appropriate connector that has a function that is required to execute a particular application.

In any event, the teachings relied upon from Sakanishi to teach the claim 1 “management unit” have absolutely nothing to do with the claim 1 “managing unit” because the claim 1 “managing unit must analyze “application data to determine a connector that specifies information indicating a function required for executing said application” (emphasis added), not something that will analyze a software file “to determine premise software of the distributed

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<sup>1</sup> As explained at col. 2, lines 56-64 of Sakanishi, “premise software” is simply “software required for using the object of distribution.”

software, or a premise-software management table” as taught by Sakanishi.

In addition, the outstanding action lacks any explanation as to how the Sakanishi teaching of analyzing a software file “to determine premise software of the distributed software, or a premise-software management table” would have been used to modify the Abileah paragraph [0077] “**creation** for a connector that is required to match interface requirements between an adapter and an application.” This is a clear violation of MPEP §706.02(j) that requires the examiner to identify “the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter” in order to support a rejection under 35 U.S.C. 103(a). In addition, the requirement of the Supreme Court that “there must be some **articulated reasoning** with some **rational underpinning** to support the legal conclusion of obviousness” (emphasis added, see *KSR Int’l v. Teleflex Inc.*, 127 S.Ct. 1727, 82 USPQ2d 1385, 1396 (2007) quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)) has also been ignored.

Here the proposed modification is identified only as a vague incorporation of the “general concept illustrated by Sakanishi, in order to successfully access a function for application execution” that has nothing to do with the claim 1 “application managing unit **that analyzes application data to determine a connector that specifies information indicating a function required for executing said application**” (emphasis added) at page 3, lines 16-17 of the outstanding Action. Similarly, the noted “motivation of providing the benefit of issuing transaction data based on required application specifics” (noted at page 3, lines 17-18 of the outstanding Action) has nothing to do with the claim 1 “application managing unit **that analyzes application data to determine a connector that specifies information indicating a function required for executing said application**” (emphasis added).

Furthermore, the allegations at lines 15-18 of page 3 of the outstanding Action ignore the claim 1 requirement that the “connector obtaining unit” must be “responsive to the application management unit determination of the connector so as to obtain the connector” as well as apparently improperly equating the term “obtain” to the actual creation of a connector based on the Abileah paragraph [0077] disclosed “standardized metamodels.” To make the difference even clearer, claim 1 has been amended to require that the “connector obtaining unit responsive to the application management unit determination of the connector” must “provide access to the connector.”

In addition, it is clear that the outstanding Action has improperly relied on Sakanishi in terms of extracting specific teachings out of the Sakanishi context and then improperly turning these specific teachings into expanded abstract concepts that are not actually taught by Sakanishi. there from that are then expanded teachings from each of these references. This approach clearly violates precedent. *See In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“[reference] statements cannot be viewed in the abstract” because “they must be considered in the context of the teaching of the entire reference.”).

Furthermore, this erroneous taking of Sakanishi teachings out of context and improperly expanding them into an unexplained “general concept illustrated by Sakanishi” (see page 3, line 16 of the outstanding Action) is a violation of precedent as it involves the prohibited use of unfounded assumptions and/or speculation as a substitute for actual reference teachings. *See In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967) (“The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not ... resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.”).

In the final analysis, the outstanding Action does nothing but suggest a “piecemeal reconstruction” of unrelated reference disclosures that are improperly broadened into “concepts” based upon applicants’ disclosure instead of any actual prior art teaching that violates precedent. *See In re Rothmel*, 276 F.2d 393, 396, 125 USPQ 328, 331 (1960), for example. Moreover, even this “piecemeal reconstruction” augmented by the noted improper expansion of actual reference teachings into concepts falls short of establishing a *prima facie* case of obviousness as the amended claim 1 requirement for a “connector obtaining unit responsive to the application management unit determination of the connector so as to provide access to the connector” has not been shown to be taught or suggested.

Accordingly, the withdrawal of the improper rejection of independent claim 1 under 35 U.S.C. § 103(a) is respectfully submitted to be required.

Furthermore, as claims 3-7, and 15 depend directly or indirectly from independent parent claim 1 they are respectfully submitted to be improperly rejected under 35 U.S.C. § 103(a) as unpatentable over unpatentable over Abileah in view of Sakanishi for at least the same reason as noted above as to parent independent claim 1.

Accordingly, the withdrawal of the improper rejection of dependent claims 3-7 and 15 under 35 U.S.C. § 103(a) is also respectfully requested.

**B. Claims 2, 8, 9-14, 16, and 17**

The outstanding Action sets forth rejections of claims 2, 8, 9-14, 16, and 17, all of which depend directly or indirectly from claim 1, as follows:

a rejection of dependent claim 2 under U.S.C. §103(a) as being unpatentable over Abileah in view of Sakanishi and further in view of Sharma et al. (U.S. Patent No. 6,976,061, hereinafter “Sharma”);

a rejection of dependent claims 8, 13, and 14 under 35 U.S.C. §103(a) as being unpatentable over Abileah in view of Sakanishi and further in view of Schiller et al. (U.S. Patent Application Publication No. 2002/0007491, hereinafter “Schiller”);

a rejection of dependent claim 9 under 35 U.S.C. §103(a) as being unpatentable over Abileah in view of Sakanishi and further in view of Trimberger et al. (U.S. Patent No. 7,269,724, hereinafter “Trimberger”);

a rejection of dependent claim 10 under 35 U.S.C. §103(a) as being unpatentable over Abileah in view of Sakanishi and further in view of Jarvensivu (U.S. Patent Application Publication No. 2002/0188736);

a rejection of dependent claims 11 and 12 under 35 U.S.C. §103(a) as being unpatentable over Abileah in view of Sakanishi and further in view of Jarvensivu and Tanaka (U.S. Patent No. 5,845,069); and

a rejection of dependent claims 16 and 17 under 35 U.S.C. §103(a) as being unpatentable over Abileah in view of Sakanishi and further in view of Thompson (U.S. Patent No. 5,465,401).

These rejections are first of all traversed because none of the added references (Sharma, Schiller, Trimberger, Jarvensivu, Tanaka, and Thompson) cure the above noted deficiencies of Abileah in view of Sakanishi. Thus, dependent claims 2, 8, 9-14, 16, and 17 clearly patentably define over these applied references for at least the same reasons that claim 1 does.

Furthermore, just as Sakanishi is not analogous art that can be used in an obviousness rejection in combination with Abileah under the above-noted provisions of MPEP § 2141.01(a), neither are at least Schiller (video-on-demand), Trimberger (using a physical interface connector

with pins), Tanaka (IC card management) nor Thompson (multiple purpose personal communication devices).

In addition, it is clear that the outstanding Action has improperly relied on these references (Sharma, Schiller, Trimberger, Jarvensivu, Tanaka, and Thompson) in much the same manner as Sakanishi in terms of improperly extracting only partial teachings from each of these references out of the reference context and then improperly expanding these extracted partial teachings into far broader abstractions referred to as a “general concept illustrated by” one or the other of Sharma, Schiller, Trimberger, Jarvensivu, Tanaka, and Thompson in further clear violation of *In re Kotzab, supra*.

The requirement of MPEP §706.02(j) that the examiner is to identify “the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter” in order to support these rejections under 35 U.S.C. 103(a) has also again been ignored as has the above-noted *KSR Int’l v. Teleflex Inc.* requirement for “articulated reasoning” having “some rational underpinning to support the legal conclusion of obviousness.”

In the final analysis, the outstanding Action again does nothing but suggest a “piecemeal reconstruction” of unrelated reference disclosures transformed into broad statements of alleged “concepts” based on applicants’ disclosure that violates precedent. *See In re Rothermel, supra*. The outstanding Action also fails to properly address all the limitations of parent independent claim 1 as noted above.

Accordingly, the withdrawal of these improper rejections of dependent claims 2, 8, 9-14, 16, and 17 under 35 U.S.C. § 103(a) are also respectfully requested.

### **C. Claim 33**

The outstanding Action sets forth a rejection of claim 33 under 35 U.S.C. §103(a) as being unpatentable over Abileah in view of Sakanishi and further in view of Fadem (U.S. Patent No. 5,090,013). This rejection is respectfully traversed.

The outstanding Action adds reliance on paragraph [0053] of Abileah in addition to paragraph [0077] relied on as to claim 1. However, paragraph [0053] of Abileah simply notes that the connector being created as in paragraph [0077] will be created with a store of the functions and parameters as noted in paragraph [0053]. This paragraph [0053] teaching of

Abileah clearly cannot be reasonably interpreted to be either the claim 33 external or internal “function management unit” as these units must each be “responsive to the **location of the required function being determined by the connector management unit.**” Just as paragraph [0053] of Abileah includes no reasonable teaching or suggestion of either of the claim 33 external or internal “function management unit,” neither do lines 3-7 of paragraph [0080] of Abileah that deal with the Common Application Metamodel (CAM) that is a tool that will be used to build a connector and that is merely noted as being populated from many sources with not even a hint that any response “to the **location of the required function being determined by the connector management unit**” is required.

Apparently realizing that the relied upon teachings of Abileah fall well short of the claimed external or internal “function management unit” of claim 33, the outstanding Action turns to reliance on the above-noted teachings of the non-analogous Sakanishi reference at col. 8, lines 53-61. However, and as noted above, col. 8, lines 53-61 of Sakanishi teach analyzing a “software information file” for each software distribution to determine premise software<sup>2</sup> “or a premise-software management table” that can be used to determine what “other software is required for distribution of specific software.” These teachings clearly have everything to do with software distribution and nothing remotely reasonable to do with the claimed determining of a connector or the claimed external or internal “function management unit” that each must each be “responsive to the **location of the required function being determined by the connector management unit.**”

Just as the above noted rationale for rejecting claim 1 turned from the improperly extracted actual teachings of Sakanishi to rely on some unexplained “general concept illustrated by Sakanishi” so does the rationale of the last paragraph at the bottom of page 18 of the outstanding Action. As noted above, this rationale is a violation of established practice (note MPEP §706.02(j) that requires the examiner to identify “the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter) as well as a violation of controlling precedent (note *KSR Int’l v. Teleflex Inc. supra*; *In re Kahn, supra*; *In re Kotzab, supra*; *In re Warner, supra*; and *In re Roethermel, supra*).

Apparently realizing that the above noted rationale is still deficient, the outstanding

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<sup>2</sup> See footnote 1.

Action turns to yet another non-analogous reference to Fadem and a mere mention therein at col. 4, lines 30-34 of a physical “connector” in terms of a “standard 25 pin EIA connector” that is not even remotely pertinent to the Abileah connector or the claimed connector. Once again, the outstanding Action is in error in interpreting the teaching of the relied upon reference (here, Fadem), in failing to follow MPEP § 2141.01(a) as to analogous art) and in erroneously ignoring controlling precedent (note *KSR Int’l v. Teleflex Inc. supra*; *In re Kahn, supra*; *In re Kotzab, supra*; *In re Warner, supra*; and *In re Rothermel, supra*).

Once again, the outstanding Action finishes the rejection rationale by turning from the improperly extracted actual teachings of Fadem to rely on some unexplained “general concept illustrated by Fadem” to change the Fadem “standard 25 pin EIA connector” into the claimed subject matter requiring “an internal function management unit responsive to the location of the required function being determined by the connector management unit to be an internal location in the service utilization terminal to provide the required function from the internal location so that the required function provided from the internal location can be utilized” that has nothing to do with the Fadem “standard 25 pin EIA connector.”

Once again, the outstanding Action does nothing but suggest a “piecemeal reconstruction” of clearly unrelated reference disclosures transformed into broad statements of alleged “concepts” based only on applicants’ disclosure. This is a clear violation of *In re Rothermel, supra*. Also, the rationale is further deficient in that it fails to properly address all the limitations of parent independent claim 33.

Accordingly, the withdrawal of the improper rejection of independent claim 33 under 35 U.S.C. § 103(a) is respectfully submitted to be required.

#### **D. Claim 34**

The outstanding Action sets forth a rejection of claim 34 under 35 U.S.C. §103(a) as being unpatentable over Abileah in view of Sakanishi and Fadem further in view of Trimberger.

This rejection is first of all traversed because the added Trimberger reference cures none of the above noted deficiencies of Abileah in view of Sakanishi and Fadem. Thus, dependent claim 34 clearly patentably defines over these applied references for at least the same reasons that parent independent claim 33 does.



Furthermore, just as Sakanishi and Fadem are not analogous art that can be used in an obviousness rejection in combination with Abileah under the above-noted provisions of MPEP § 2141.01(a), neither is Trimberger that is directed to use of a physical connector like the connection cable or other interface device noted at col. 3, lines 45-46.

The outstanding Action errs by trying to turn the “connector” of lines 18-20 of claim 1 of Trimberger into a “connector” like that of Abileah or that of the present invention based upon breadth of claim language specifying a “connector.” However, it is clear from claim 11 that this “connector” is an “interface” that has pins which means it must be a physical element that has its pins arranged to be able to connect into the target system via a disclosed socket. Note the technical disclosure at col. 3, lines 45-46 and that it is well established that the PTO cannot rely on claim scope instead of the technical disclosure of a reference patent because the scope of the claims determines what infringes the patent; it is no measure of what it discloses. *In re Benno*, 768 F.2d 1340, 226 USPQ 683, 686 (Fed. Cir. 1985).

In addition, it is clear that the outstanding Action has improperly relied on Trimberger in much the same manner as Sakanishi in terms of improperly extracting only partial teachings from each of these references out of the reference context and then improperly expanding these extracted partial teachings into far broader abstractions referred to as a “general concept illustrated by” Sakanishi or Trimberger in further clear violation of *In re Kotzab*, *supra*.

The requirement of MPEP §706.02(j) that the examiner is to identify “the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter” in order to support these rejections under 35 U.S.C. 103(a) has also again been ignored as has the above-noted *KSR Int’l v. Teleflex Inc.* requirement for “articulated reasoning” having “some rational underpinning to support the legal conclusion of obviousness.”

In the final analysis, the outstanding Action again does nothing but suggest a “piecemeal reconstruction” of unrelated reference disclosures transformed into broad statements of alleged “concepts” based on applicants’ disclosure that violates precedent, *see In re Rothermel*, *supra*. The outstanding Action also fails to properly address all the limitations of parent independent claim 33 as noted above.

Accordingly, the withdrawal of this improper rejection of dependent claims 34 under 35 U.S.C. § 103(a) is also respectfully requested.

**Conclusion**

All of the stated grounds of rejection have been properly traversed and it is respectfully requested that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Raymond F. Cardillo, Jr., Registration No. 40,440 at the telephone number of the undersigned below to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Director is hereby authorized to charge any fees required during the pendency of the above-identified application or credit any overpayment to Deposit Account No. 02-2448.

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Respectfully submitted,

By 

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